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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,233	04/05/2001	Cary Lee Bates	RSW920010047US1	7213
<div>7590 10/19/2007</div> <div>Andrew M. Calderon Greenblum and Bernstein P.L.C. 1950 Roland Clarke Place Reston, VA 20191</div>				
			EXAMINER	
			ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	
			MAIL DATE	DELIVERY MODE
			10/19/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/827,233
Filing Date: April 05, 2001
Appellant(s): BATES ET AL.

MAILED

OCT 19 2007

Technology Center 2100

Andrew M. Calderon Reg. No. 38,093
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/20/2007 appealing from the Office action mailed 02/27/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6859213	Carter	2-2005
6963901	Bates et al.	11-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 is vague and indefinite because it is unclear what is the association and/or relationship between the web page and the email.

Claims 1 – 3, 8 – 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 – 3, 8 – 11 and 16 are vague and indefinite because it is unclear what is a preferred viewing order.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed

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in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 3, 5, 7, 9 – 11, 13, 15 and 17 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Carter (6859213).

As broadly drafted and as best the Examiner can ascertain from the language of the claims, claims 1-3, 5, 7, 9-11, 13, 15, and 17-20 do not define any structure/step that differs from Carter.

Carter teaches claims:

1. A method for providing email that enables a recipient of the email to navigate readily through a set of web pages associated with the email, comprising the acts of:

composing an email to be sent from an originator to a recipient; (abstract; "A method and apparatus for selecting attachments. When a sender indicates in an e-mail application or applet that an attachment is to be associated with an e-mail message, an attachment chooser window is presented. The attachment chooser window provides a browser-based graphical user interface (GUI) which allows a sender to browse data resources, such as HTML documents and associated links. An attachment mechanism is provided by which a sender can choose a currently displayed data resource for attachment in an e-mail message. In one embodiment, the attachment mechanism allows a user to select whether the attachment is retrieved and attached to an e-mail message as a resource locator (such as a URL) of the chosen data resource, or whether source data of the data resource is retrieved and attached to the e-mail message as one or more source files.")

in response to input of the originator, generating a web page navigation ("a browser-based graphical user interface (GUI) which allows a sender to browse data resources") that includes

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a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient; (col.3, lines 17-41)

associating the navigation with the email; and (307)

sending the email and the navigation to the recipient. (col.3, lines 17-41; col.4, line 45-col. 5, line 26)

2. A method for guiding a recipient of an email readily through a set of web pages associated with the email (Figs. 5A, 5B), comprising the acts of:

receiving an email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

receiving a web page navigation associated with the email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

passing the web page navigation to a web browser; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

displaying by the web browser (400) a preferred viewing order in which web pages identified by the web page navigation are to be viewed; and (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

wherein the preferred viewing order is included in the navigation. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

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3. A method for providing email that guides a recipient readily through a set of associated web pages (Figs. 5A, 5B), comprising the acts of:

composing an email to be sent from an originator to a recipient; in response to input of the originator, generating a web page navigation (400) that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;

(abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

sending the email and the web page navigation to the recipient; passing the web page navigation to a web browser used by the recipient; and displaying by the web browser an indication of the preferred viewing order. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

5. The method of claim 3, wherein the indication of the preferred viewing order is provided by icons. (216)

7. The method of claim 3, wherein the indication of the preferred viewing order is provided by forward and backward browser controls. (403,404)

9. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages, the programmable software comprising the acts of:

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composing an email to be sent from an originator to a recipient; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

in response to input of the originator, generating a web page navigation (400) that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient; associating the navigation with the email; and sending the email and the navigation to the recipient. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

10. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages (Figs. 5A, 5B), the programmable software comprising the acts of:

receiving an email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

receiving a web page navigation associated with the email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

passing the web page navigation to a web browser; and displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

wherein the preferred viewing order is included in the Web page navigation. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and

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"Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

11. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages (Figs. 5A, 5B), the programmable software comprising the acts of:

composing an email to be sent from an originator to a recipient; in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

sending the email and the web page navigation to the recipient; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

passing the web page navigation to a web browser used by the recipient; and (passing 500 to 501)

displaying by the web browser an indication of the preferred viewing order. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and

"Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

13. The method of claim 11, wherein the indication of the preferred viewing order is provided by icons. (216)

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15. The method of claim 11, wherein the indication of the preferred viewing order is provided by forward and backward browser controls. (403,404)

17. The method of claim 1, wherein the preferred viewing order is specified by the originator and the email sent to the recipient contains the plurality of uniform resource locators and the preferred viewing order. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

18. The method of claim 1, wherein an email program of the originator and a web browser of the originator together generate the web page navigation. (abstract; col.3, lines 17-41; col.4, line 45 - col. 5, line 26)

19. The method of claim 1, wherein the web page navigation is incorporated into the email sent to the recipient. (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

20. The method of claim 1, further comprising: receiving the email and the web page navigation with an email program of the recipient; passing the web page navigation to a web browser of the recipient; and displaying an indication of the preferred order with the web browser of the recipient. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by

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sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6, 8, 12, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter in view of Bates et al. (6963901) (hereinafter Bates).

Cater discloses all of the claimed limitations except for a showing of a preferred viewing order having various link colors and fonts.

Bates is applied for showing a browser program 240 (e.g. font, color, background, screen sizing, display attributes and other user configurable settings; at col.4, lines 25-35, col. 4, line 57-col 5 line 15) having preference file 244 for navigating web links.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use Carter's method and apparatus to select attachments to navigate readily through a set of web pages associated with an email and to select any desirable view/display order, as taught by Bates, by incorporating a preferred colored links and/or fonts in order to provide a visible mark to show the degree of importance and order ranking.

Response to Arguments

Applicant's arguments filed 11/06/2006 have been fully considered but they are not persuasive.

In the Remarks, Applicant argues in substance that there is no requirement under 35 U.S.C. § 112, second paragraph, that each recited feature of a claim have an association or relationship to another recited feature. Nor has the Examiner cited any basis in law for such an assertion. Even if the Examiner were correct, the Examiner would have to ignore the clear language of claim 2 to make such an assertion because claim 2 in fact recites receiving a web page navigation associated with the email. Thus, the Examiner's assertion is without legal basis and contradicted by the very claim language asserted to be indefinite. Furthermore, Applicants submit that contrary to the Examiner's assertions, Applicants are not required under section 112, 2nd paragraph, to limit the invention to any particular cooperative relationship between the recited steps. To the extent that the Examiner relies upon MPEP 2172.01, the Examiner has misread MPEP 2172.01, which indicates that when it is indicated "by applicant" in the specification that certain features are essential to the invention, such features must be recited in the claims. The Examiner has identified no features which were indicated "by Applicant" to be critical and which are not recited in the claims.

As to the first Remark, Applicant is misunderstanding the reason for the rejection and is citing section of the MPEP that do not apply. What is meant by rejection which states "that the claim is indefinite because it is unclear what is the association and/or relationship between the web page

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and the email is, "How is the web page navigation associated with the email?" What makes the web page connected to the email? In the independent claim 1, it is understood the relationship between the web page navigation and the email because it is stated that the URLs are composed in the email by the input of the originator. Claim 2 is void of such language or any language that states the web page navigation and URLs are attached in the email. Rejection still stands and await clarification or cancellation.

In the Remarks, Applicant argues in substance that the Examiner asserts that claims 1-3, 8-11 and 16 are indefinite because "it is unclear what is a preferred viewing order." Applicants respectfully disagree with this assertion of indefiniteness. Applicants note that the specification clearly and specifically explains what is meant by the language asserted to be indefinite. Applicants note, for example, that the language "preferred viewing order" relates to a viewing order that is defined by the originator and which informs the recipient that the URLs provided in the email should be viewed in a particular order designated by the originator. The term "preferred" is not being used in the way typically found to be objectionable under current USPTO rules, such as when it is used to designate alternative features and/or both broad and narrow definitions of the same recited feature in a claim, e.g., a device comprising a fastener, preferably a screw.

As to the second Remark, Applicant has not pointed to any part of the specification to support their meaning of the phrase "preferred viewing order". Furthermore, the Applicant state above in their remarks, *"Applicants note, for example, that the language "preferred viewing order" relates to a viewing order that is defined by the originator and which informs the recipient that*

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the URLs provided in the email “should” be viewed in a particular order designated by the originator.” This would leave one to interpret that the receiver does not have to abide by the “preferred order” and therefore could be interpreted and just an order, random or planned. With this understanding and description that the Applicant has given, this would mean that the “preferred order” has no patentable wait because if the receiver does not have to abide by the order then the “preferred order” is arbitrary. Applicant is asked to give a confirm or state otherwise why this interpretation is incorrect while pointing out specific sections of the specification to support their response.

In the Remarks, Applicant argues in substance that Carter does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

As to the final Remark, Applicant is asked to draw their attention to Figures 4 – 7 and columns 7 et seq., along with sections previously cited, in view of the Applicant’s claim language.

Applicant does not claim specifically what “a preferred viewing order” could be and therefore can be interpreted as any order the “originator” deems fit, i.e., the order is not program determined and can be any order selected by the “originator”. Now if the Applicant will view column 7, line 36 – column 8, line 47, one can obviously see that Carter teaches the prior art of a “viewing order” and “a selected or preferred viewing order”. Carter teaches a “GoTo” field 402 which is used to provide on the “chooser interface” which contains the URL of the current web page and permits the sender to specify a particular URL which is then displayed in the display region 400. The sender can then enter another URL in the GoTo field and request that URL. This

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action then activates the “previous page button” and allows the sender to use this button similarly as a previous button on a web browser and when selected allows a user to go to the previously view page by accessing the history of the display region 400, e.g., col. 8, lines 26 – 47 & col. 11, line 17 – col. 13, line 34. Furthermore, as taught in column 12, the program can attach a URL to the email that is in the GoTo field. This would also make very apparent to one of ordinary skill in the art that once a sender has chosen an URL to attach to the email, the sender can then select a link or type in manually in the GoTo field another URL to attach to the email. This would now start the “document stack”, col. 12, line 12 – col. 13, line 34, that is accessed from a receiver or sender to view the different attached URLs that are attached using the “next button” or “previous button”. Since it is in the senders complete control as to what they would like save as an attachment in the email, then that would mean they can determine a “preferred order” if they so deem for the recipient, which is saved from the history of URLs that are placed in the GoTo field.

Applicant’s arguments in regards to Bates also fall under the assumption that Carter does not teach the claimed invention and therefore the response above can be applied here with the same rational.

Applicant is invited to contact the Examiner to clear up any ambiguity or discuss claim amendments to further prosecution.

(10) Response to Argument

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In the Arguments, Appellant argues in substance that the rejection under 112 2nd, in regards to claim 2 and its limitation of “web pages associated with the email”, is in error and that 112 2nd does not require that each recited feature of a claim have an association or relation ship to another recited feature. Appellant further goes on to state that the specification provides this function in step 215 of Figure 2 in paragraph [0021] of the specification, i.e., associating the navigation with the email.

As to the First Argument, Examiner agrees with the Appellant in that 112 2nd does not “require that each recited feature of a claim have an association or relation ship to another recited feature.” This was not the purpose of the rejection. The purpose of the rejection was to bring to light that it is unclear the link between the navigation and the email. Regardless, Examiner would like to withdraw the rejection since it isn’t a clear 112 2nd rejection, just a broad limitation.

In the Arguments, Appellant argues in substance that Carter does not teach “in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient; associating the navigation with the email; and sending the email and the navigation to the recipient.” Appellant acknowledges that Carter discloses the sending of an email with attached HTML documents. However, does not teach that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

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As to the Second argument, it is very clear that Carter teaches every limitation in the independent claims. Firstly, it is never stated what a “preferred viewing order” is or could be. Therefore, a user may select any order that they may desire and is not up to any processor or program the order that is selected. Furthermore, it is unclear as to how one “associates the navigation with the email”, and therefore leaves a broad interpretation. As stated by the Appellant, the prior art of Carter teaches attaching HTML documents to an email. If the Applicant were to draw their attention to column 7, lines 25 et seq., it states that the GUI uses an attach button or menu item to attach a HTML document to an email. In selecting the attachment button to attach a HTML document, the program triggers the presentation of a new window or frame providing an attachment chooser GUI interface. Further down the column, it states that a “GoTo” field is provided on the chooser interface which contains the resource locator, URL, of the current web page. The GoTo field is editable and permits the sender to specify a particular resource locator and entering the URL causes the chooser interface to display the associated data resource or web page. It is stated in line 39 of column 7 that the attachment chooser GUI is configured as a web browser. At column 7, line 53 et seq., it is stated that the chooser interface has navigation controls such as “previous page”, “next page” and so on, similar to a standard browser. This understanding would leave one to believe that the URLs that are entered have an order if one can navigate from one to another using the “previous page” and “next page” supplied by the chooser interface. But to have this type of browsing ability one would have to save the information entered into the “GoTo” field, such as a history. Starting at line 4 of column 8, one can see that Carter talks about attaching the displayed URL to the email and a resource locator history when the attachment session begins and using the previous/next page navigation buttons if there is

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navigation history. Therefore, one can choose a preferred order by manually entering into the GoTo field the URLs they wish to attach one at a time and the history of the URLs are recorded and can be viewed by selecting the Previous Page or Next Page button on the chooser interface. It is well known in the art that one can supply multiple attachments to an email.

Now jumping to column 12, lines 57 et seq., one can see that a “document stack 504 maintains the browser history in the form of a stack of URL’s, providing the record necessary for the forward and back navigation familiar to web browsers. This document stack and the previous and next buttons on the chooser allows the preferred viewing order that the Appellant’s applicant claims. This is further proven by Figures 4 – 7.

In the Arguments, Appellant argues in substance that Carter does not teach associating a navigation with the email and/or sending or receiving the email and the navigation and the files which can be attached to the e-mail can be a navigation which is used by the receiver. Carter’s GUI only appears to be used for the sender and not the receiver.

As to the Third argument, Examiner would like to draw the Appellant’s attention to their claim language. There is no specific language that states how the recipient is to view the attachments, only that the attachments are in a “preferred viewing order” and how the navigation is used at the recipient’s email. As is well known in the art, when one attaches multiple documents to an email and it is in the order they are attached. That would mean that a user could attach a first web site to view then a second and that would be a preferred order of viewing. Furthermore, since the claimed invention is also silent on how the navigation is used at the receivers end in the

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independent claim, it could be interpreted as once the recipient selects the first attachment, a browser is launched and one views the first attachment. Then the recipient selects the second attachment and the browser changes to the second web page. Now that the two attachments are loaded into the recipient's browser, they may "navigate" back and forth between the two by conventional browsing means, the back and forward buttons on IE Explorer or Netscape.

As for Carter not teaching the navigation of the sender, the Examiner would like to point out to the Appellant that the claim language talks about how to attach web pages to the email in an order which is stated by Carter as mentioned above and in an order. Carter teaches entering one URL and attaching it and then attaching another if needed. This would be the "preferred viewing order". The claim language does not state what the order is or how it is displayed or how the "navigation" is set up at the recipients end. Therefore it can be interpreted that the "preferred order" is the order in which the web pages were attached, as stated in Carter, and the navigation appears to be the attachments themselves or web pages that the user selects. This is even more apparent in Claim 2, in which a recipient receives the email and selects the web page to be viewed and is "navigated" with the site by a browser. The preferred viewing order can be interpreted as how the recipient wishes to view the attachments or web pages. Therefore, it can be interpreted that the user is given an order but selects any web page to view then a subsequent attached web page.

All other arguments made by the Appellant with regard to the 102(e) rejection appear to fall under the same arguments supplied above and therefore the same response to the arguments above can be applied to the other arguments. Specifically, the Appellant does not specifically

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claim or disclose in the claim language what the “preferred viewing order” is or what the navigation entails and therefore the prior art of Carter teaches the claim language.

The arguments stated for claims 8 and 16 are the same arguments stated above and therefore the same response to the arguments above are applied to claims 8 and 16.

In the Arguments, Appellant argues in substance that Bates does not teach with regard to link colors that provide an indication of the preferred viewing order.

As to the Forth Argument, Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Arguendo, Appellant is asked to draw their attention to line 21 of column 3 in Bates. It is stated that email is used to communicate the browser information between computers. Further into Bates it is stated that a series of data input windows for establishing the preferences contained in the preferences file 224. and that the information that is located in the buffer for transmitting to another computer via email can be edited in the way it is presented, e.g., column 5, line 7, 47 and column 6, line 6. As stated in column 6 the modifying of information is used on all browser information stored in the buffer and then sent to another user. Now in column 7, lines 13 et seq. it states that, “the checkbox is entitled “customizable preferences of browser. Such as color,

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sound, finds, display attributes and the like.” Line 32 states that each checkbox may be similarly configured to further define the browser information to be sent/received.

The claim language only specifies that the a preferred viewing order can be a link color but does not claim that each separate web page that is attached to the email has a different color, only that they can be colored. Therefore, utilizing what is known by Carter, in combination with Bates, the user may apply colors or different display attributes for each web page attached to the email.

Which reads on one interpretation of the claim language. Arguments in regards to claim 12 fall under the same characteristics as above and therefore the response is the same as applied to claim 4.

Claims 6 and 14 are similar in nature in that they disclose a font characteristic which can be interpreted broadly as the color which is stated in claims 4 and 12. Therefore, arguments on claims 6 and 14 are responded to in similar light as claims 4 and 12 above.

(11) Related Proceeding(s) Appendix

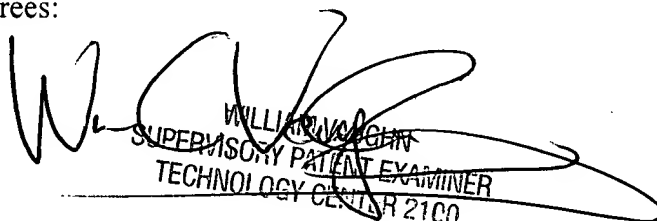
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

DE 

Conferees:


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